

ESTTA Tracking number: **ESTTA305587**

Filing date: **09/10/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91188035
Party	Defendant ADVANCE WATCH COMPANY LTD.
Correspondence Address	MATTHEW R. MOWERS BROOKS KUSHMAN P.C. 1000 TOWN CTR FL 22 SOUTHFIELD, MI 48075-1183 UNITED STATES
Submission	Opposition/Response to Motion
Filer's Name	Hope V. Shovein
Filer's e-mail	hshovein@brookskushman.com, mmowers@brookskushman.com, ejbrooks@brookskushman.com
Signature	/hope v shovein/
Date	09/10/2009
Attachments	ADW Response to Opposers' Motion for Leave to Amend 9-10-09.pdf ( 8 pages ) (120072 bytes )

**UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD**

---

Guess? IP Holder L.P. and Guess?, Inc.,

Opposers

Opposition No. 91188035  
Application No. 77/304,064

v.

Advance Watch Company Ltd.,

Applicant.


---

**APPLICANT'S BRIEF IN OPPOSITION TO  
OPPOSERS' MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**


## I. INTRODUCTION

Applicant, Advance Watch Company Ltd. (“Applicant”) hereby responds to Opposers’, Guess? IP Holder L.P. and Guess?, Inc.’s (“Opposers”), Motion for Leave to Amend its December 5, 2008 Notice of Opposition. Applicant does not consent to Opposers’ amendment and respectfully requests that the Board deny Opposers’ Motion to Amend.

Opposers filed the original Notice of Opposition on December 5, 2008, which Applicant duly answered on January 26, 2009. Opposers instituted this proceeding to prevent

Applicant’s registration of Application Serial No. 77/304,064 for the mark  for “timepieces and chronometric instruments, namely, alarm clocks, wall clocks and parts therefore; clock accessories, namely, clock cabinets, housings, cases, gears, pendulums, hands, face inserts and dials,” in International Class 14.

Opposers based this opposition proceeding on prior use of “the mark GC, alone and in combination with other terms and designs (hereinafter the ‘GC Marks’), in connection with the sale of a variety of fashion and consumer products, *including jewelry and watches.*” (Notice of Opp. ¶ 2.)


Opposers now seek to amend the opposition to assert Registration No. 3,605,306 (“the ’306 Registration”) for the mark  for “*bracelets; earrings; horological and chronometric instruments and parts thereof; cuff links and tie clips; lapel pins; necklaces; rings; watchbands; wrist watches; key rings of precious metal; jewelry; pocket watches; clocks*” in International Class


14, which was filed May 19, 2008 – approximately seven (7) months before Opposers’ December 5, 2008 Notice of Opposition.<sup>1</sup>

For the reasons set forth below, Applicant respectfully requests that the Board deny Opposers’ Motion to Amend.

---

<sup>1</sup>It should be noted that Opposers’ objection to Applicant’s registration of Application

Serial No. 77/304,064 for the mark  is puzzling, given that Opposers do not appear to claim adverse affect from coexisting third-party use and registration of stylized “GC” marks used in connection with jewelry and timepieces, including at least the following:

Greenleaf & Crosby’s Registration No. 1,626,705 for  ;


ÇAK Textile B.V.’s Registration No. 3,472,439 for  ;

Govanni Jewelers International Inc.’s Registration No. 3,146,504 for  ;

Gabriel & Co.’s Registration No. 2,849,385 for  ;

Gem Center Northwest, Inc.’s Registration No. 1,633,991 for  ;

The Gem Company, Inc.’s Registration No. 2,440,609 for  ;

Vahan Baharoglu’s (d/b/a Golden Creations) Registration No. 1,777,807 for  ;

Goldenwest Diamond Corporation’s Registration No. 1,781,328 for  ; and

Good Charma, Inc.’s Registration No. 3,493,329 for  .

## II. DISCUSSION

### A. Leave to File Amended Notice of Opposition

As a general rule, pleadings in inter partes proceedings before the Board may be amended in the same manner and to the same extent as pleadings in a civil action before a United States district court. TBMP § 315. Fed. R. Civ. P. 15(a) states, in relevant part: “...leave shall be freely given *when justice so requires*.” However, justice does not require that leave be granted in the present proceeding before the Board. Opposers’ 2(d) claim was legally insufficient via the original Notice of Opposition, as Opposers cannot claim exclusive rights in the letters “GC”, and Opposers’ amended Notice of Opposition does not replace or revise Opposers’ claim of exclusive rights in the letter “GC”.<sup>2</sup> Rather, Opposers seek to add to their already overbroad claim a registration for a specific stylization of the letters “GC”, without claiming that the stylizations of the parties’ marks are confusingly similar. Moreover, Opposers also seek to broaden their claim of rights to encompass “clocks” via the amended Notice of Opposition. As the following more fully explains, Opposers intentionally neglected to amend the Notice of Opposition, and Opposers’ delayed amendment will result in prejudice to the Applicant. As such, leave to amend should be denied.

---

<sup>2</sup>Indeed, Applicant addressed the insufficiencies in its Answer to the Notice of Opposition: “Opposers vaguely define their ‘GC Marks’ in Paragraph 2 as ‘the mark GC, alone and in combination with other terms and designs.’ Applicant is without knowledge or information sufficient to identify Opposers’ additional marks, and therefore denies the remaining allegations contained in Paragraph 5.” (Answer, ¶ 5.) Applicant also affirmatively defended the Opposition as follows: “Opposers’ Notice of Opposition fails to state a claim upon which relief can be granted, *in particular, fails to state legally sufficient grounds for sustaining the opposition.*” (Answer, Affirmative Defense 1.) Given Applicant’s early efforts to address the insufficiencies in the Notice of Opposition, Opposers’ glaring delay in addressing these insufficiencies, and the fact that the proposed amendment does not cure the insufficiencies, Opposers’ motion for leave to amend – filed 259 days after filing the original Notice of Opposition – should be denied.

**B. Opposers' Delay Was the Result of Willful Conduct and Gross Neglect**

Opposers waited until the eve of the close of discovery – more than eight (8) months after filing the subject Notice of Opposition and more than four (4) months since the '306 Registration issued – to seek amendment of the Notice of Opposition to add the '306 Registration. The amendment was apparent long ago. An opposer is required to specifically plead any registration upon which it is basing its opposition, and no consideration is given to any registration which was not specifically plead . *See Hard Rock Café Licensing Corp. v. Elsea*, 48 USPQ2d 1400, 1402 n.3 (TTAB 1998) and 37 C.F.R. §2.106(b)(2) (“A pleaded registration is a registration identified by number and date of issuance in an original notice of opposition...”).

Perhaps equally relevant is the fact that the registration that Opposers seek to add was filed on May 19, 2008, well before the filing of the December 2008 Notice of Opposition. Opposers likely opted not to include their pending Application No. 77/478,564 (which matured into the '306 Registration) in the Notice of Opposition, as the Application that is subject of this proceeding has priority (Application No. 77/304,064 filed October 15, 2007). Therefore, Opposers now seek to support their priority claim by relying on the '306 Registration in lieu of coming forth with evidence of prior use.

**C. The Delay Will Result in Substantial Prejudice to Applicant**

Should the Board grant Opposers' leave to file an Amended Notice of Opposition, it would cause unnecessary delay and costs, and create a disadvantage to the Applicant, as Applicant has formulated a position based on the pleadings. Applicant formulated its position based on the initial Notice of Opposition. Opposers' “allegations” contained in the Notice of Opposition were necessary for Applicant to proceed with discovery.

For instance, Opposers initially asserted ownership of “the mark GC, alone and in combination with other terms and designs (hereinafter the ‘GC Marks’), in connection with the sale of a variety of fashion and consumer products, *including jewelry and watches.*” According to the original Notice of Opposition, Opposers only claimed use of “GC” in connection with jewelry and watches. However, the ’306 Registration covers “bracelets; earrings; horological and chronometric instruments and parts thereof; cuff links and tie clips; lapel pins; necklaces; rings; watchbands; wrist watches; key rings of precious metal; jewelry; pocket watches; clocks” in International Class 14, which is considerably broader than the goods asserted in the original Notice of Opposition. Therefore, should the Board, in its discretion, opt to allow Opposers to amend the Notice of Opposition to include the ’306 Registration, the Board should limit Opposers’ reliance on the ’306 Registration to the goods identified in the original Notice of Opposition, namely, “jewelry and watches.”

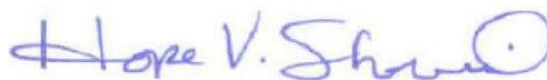
### **III. CONCLUSION**

The Federal Rules of Civil Procedure dictate that leave shall be freely given *when justice so requires*. Opposers have not established that justice requires the requested amendment. Opposers have not provided any reasons as to why they only sought to assert the '306 Registration at this late stage. Opposers merely indicate that the '306 Registration "only recently issued in April of 2009," and go on to make excuses that "[t]he few-month delay between the time when the registration issued and the filing of this motion does not reflect dilatory conduct..." (Motion, p. 3.) However, Opposers did not wait a "few" months. Opposers waited more than four months, until the very eve of the close of discovery, to move to amend. Such delay is unjustifiable dilatory, such that *justice does not* require leave to amend the Notice of Opposition.

For the foregoing reasons, Applicant asks that the Board deny Opposers' Motion for Leave to Amend the Notice of Opposition.

Respectfully submitted,

**BROOKS KUSHMAN P.C.**



By: \_\_\_\_\_

Matthew R. Mowers  
Hope V. Shovein  
1000 Town Center  
Twenty-Second Floor  
Southfield, Michigan 48075  
*Attorneys for Applicant*

Dated: September 10, 2009

**CERTIFICATE OF SERVICE**

I certify that I served:

**APPLICANT'S BRIEF IN OPPOSITION TO  
OPPOSERS' MOTION FOR LEAVE TO AMEND NOTICE OF OPPOSITION**

on September 10, 2009 by:

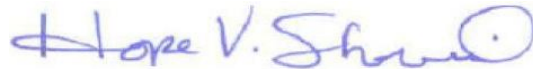
delivering

mailing (via First-Class mail)

a copy to:

Steven E. Lauridsen  
P.O. Box 7068  
Pasadena, California 91109-7068

*Attorney for Opposers*

A handwritten signature in blue ink that reads "Hope V. Shum" with a circled "O" at the end. Below the signature is a horizontal line.

---